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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,975	07/12/2003	David R. Payne	82380-00661	4897

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MCKINNEY & STRINGER, P.C.
101 N. ROBINSON
OKLAHOMA CITY, OK 73102

EXAMINER

ADDIE, RAYMOND W

ART UNIT PAPER NUMBER

3671

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/617,975

Applicant(s)

PAYNE ET AL.

Examiner

Raymond W. Addie

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hesse et al. # 5,833,015 in view of Aft # 6,308,787 B1.

Hesse et al., discloses a method for drilling and backreaming a horizontal bore hole, the method comprising:

Automatically rotating and pulling a drill string (3), having a backreamer (5) through the horizontal borehole.

Automatically reducing a rate of pullback if a rotation pressure on the drill string is greater than a predetermined limit.

Automatically reducing the rate of pullback if a rotation speed of the drill string is less than a predetermined limit.

Increasing the rate of pullback if the rotation pressure is less than the predetermined limit, increasing the rotation speed of the drill string is greater than a predetermined limit, and the product tension at the backreamer (24) is less than a predetermined limit.

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Attaching a utility line(8) to the backreamer after the boring tool (26) has exited the earth at location (24).

See Hesse et al. Col. 3, ln. 50-col. 5, ln. 23.

What Hesse et al. does not disclose is automatically reducing the length of the drill string.

However, Alft teaches a method of operating a horizontal boring machine having an automated drill string (22), which can be lengthened or shortened automatically or manually, by removing a pipe section from the drill string, either automatically or manually. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to provide the method of forming a bore hole, of Hesse et al., with the method of automatically lengthening or shortening the drill string when the drill string needs to be lengthened or shortened, as taught by Alft et al., in order to maximize boring efficiency. See Alft col. 12, lns 5-20.

In regards to claim 6, Hesse et al. discloses it is desirable to pull a utility line through a borehole, by attaching the utility line (8) to a drill head (5), and to transmit operational data from the bore head to the drilling machine to maximize boring efficiency. What Hesse et al. does not disclose is recording the actual location of the utility line as the utility line is automatically pulled through the borehole via a transmission line disposed within the drill string.

However, Alft discloses it is known to track the position of a drill head (24) in real time, using a sonde-type transmitter and remote control unit that uses a traditional methodology for locating the drill head. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to provide the method of backreaming a borehole of Hesse et al. with the method of tracking the drill head, as taught by Alft, in order to continuously determine and record the location of the utility line, connected to the drill head. See col. 12, Ins.10-41, col. 16, Ins. 16-29.

In regards to Claims 8-11 although neither Hesse et al., nor Alft explicitly recite reducing the rate of pullback of the drill string by a certain percentage; both Hesse et al., and Alft does disclose that the rate of pull-back can be reduced or terminated based upon whether the rotation speed, rotation pressure(torque) of the drill string, or the product tension (lubricating mud pressure) is above or below a pre-determined level. Hence, it would be obvious that the amount of reduction required could be correlated to a specific percentage of the current rate of pull back of the drill string. See col. 44.

Response to Arguments

2. Applicant's arguments filed 11/05/04 have been fully considered but they are not persuasive.

Applicant argues in favor of Independent Claim 4 by stating "Each step of the method claim requires automatic operation of the step, without human intervention".

Applicant then suggests "The Hesse reference...also mentions the measurements could be provided to an automatic control, but the reference lacks any disclosure of structure for an automatic control device or how to automatically control the drive...the Hesse reference also does not disclose automatically reducing the length of the drill string, as is required by Applicants' present invention".

Applicant then suggests "Alft broadly suggests that the processor may operate parts of the drilling system...Alft does not, however, adequately describe or teach the operation of the processor to control a pipe handling system to automatically reduce the length of the drill string when the drill string must be shortened".

Applicant then states "Alft also states the machine controller 74 also controls rotation pump movement when threading a length of pipe onto a drill string 180 such as by use of an automatic rod loader apparatus of the type disclosed in commonly assigned U.S. Patent No. 5,556,253, which is hereby incorporated herein by reference in its entirety".

However, the Examiner does not concur.

An incorporation by reference in the arguments is not afforded the same benefit as an incorporation by reference in the specification. Applicant's specification does not incorporate 5,556,253 to Rozendaal et al.

Further, if the reference were incorporated by reference, and the reference does not teach "a controller or any automatic control" as argued, it is unclear as to how Applicants' method is performed by Applicant invention.

Applicant's further incorporation by reference of U.S. Patent No. 6,179,065 also

is made only in the arguments and not in the specification, and hence is not afforded the same benefit.

Further, Applicant's admission that "Alft broadly suggests that the processor may operate parts of the drilling system...Alft state 'a pipe loading controller 141 may be employed to control an automatic rod loader apparatus during rod threading and unthreading operations...See col. 30, Ins. 30-32"; clearly shows Alft reasonably suggests automatic control of shortening the drill string by unthreading adjoined drill string sections. Hence, it is obvious the combined teachings of Hesse in view of Alft teach a method of automatically backreaming a horizontal borehole including the step of automatically reducing a length of the drill string by automatically removing a pipe section from the drill string by unthreading adjoined drill string sections.

Therefore the argument is not persuasive and the rejection is maintained.

Applicant then argues in favor of dependent claims 5-11 by indicating that they "depend from claim 4 and include all the limitations thereof...these claims are also allowable over Hesse and Alft and the rejection of claims 5-11 should also be withdrawn".

However, the Examiner does not concur because; Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond W. Addie whose telephone number is 703 305-0135. The examiner can normally be reached on 8-2, 6-8PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on 703 308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas Will
Supervisory Patent Examiner
Group 3600

RWA
1/18/05